

## PATENT

ATTORNEY DOCKET NO. 114596-20-4009

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/434,394 Confirmation No.: 3898  
Applicant: John S. Yates, Jr., et al.  
Title: DETECTING REORDERED SIDE EFFECTS  
Filed: November 4, 1999  
Art Unit: 2122  
Examiner: Nguyen Ba, H. V. A  
  
Atty. Docket: 114596-20-4009  
Customer No. 38492

RECEIVED  
COMMUNICATIONS  
APR 14, 2005

## AFTER FINAL – EXPEDITED PROCEDURE

## REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

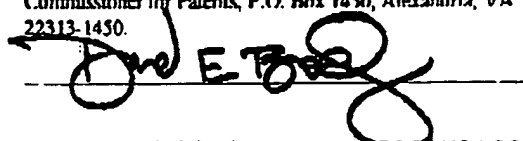
Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

05/03/2005 CBARNES1 00000007 232405 09434394  
01 FC:1251 120.00 DA  
Applicant observes that the Advisory Action of March 28, 2005 raises a new ground of rejection. All issues raised in the "final" Office Action of December 30, 2004 are apparently resolved. Pursuant to MPEP § 706.07(c) and (d), Applicant requests that the finality of the Action of December 30, 2004 be withdrawn, and that the Request for Reconsideration filed herewith be entered as of right.

I. The Advisory Action Introduces a New Ground of Rejection of an Unamended Claim

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

I certify that this correspondence, along with any documents referred to therein, is being transmitted by facsimile on April 14, 2005 to Art Unit 2122 at FAX no. 703 872 9306, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Request for Withdrawal of Finality  
This paper dated April 14, 2005

1

114596-20-4009

S/N 09/434,394  
2825318.1

no “double patenting” here. The Advisory Action is insufficient to raise any rejection at all, let alone a final rejection.

For four separate reasons, no double patenting rejection has been raised over claim 19 of Yates '181. No terminal disclaimer is warranted.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-20-4009.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: April 14, 2005

By: 

David E. Boundy

Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP

787 Seventh Ave.

New York, New York 10019

(212) 728-8757

(212) 728-9757 Fax